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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,774	08/31/2001	Ali Yahiaoui	14,832	1811

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EXAMINER
SALVATORE, LYNDA

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 02/25/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS7

Office Action Summary	Application No.	Applicant(s)	
	09/944,774	YAHIAOUI ET AL.	
	Examiner	Art Unit	
	Lynda M Salvatore	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-73* is/are pending in the application.

4a) Of the above claim(s) *26-50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25 and 51-73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-25 and 51-74 drawn to a composite material substrate, classified in classes 442 and 604, subclasses 118+ and 359+ respectively

II. Claims 26-50 drawn to a method for forming a composite material classified in class, 427, subclass various.

2. The inventions are distinct, each from the other because:

Inventions of Group I and Group II are related as product and method of making and are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made without the claimed method step of "subjecting the substrate to at least one condition which facilitates migration of the surfactant from the first layer of the substrate to the second layer of said substrate".

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. If applicant elects Group I, this application contains claims directed to the following patentably distinct species of the claimed invention: woven fabrics, knit fabrics, non-woven fabrics, foams, film-like materials and paper materials: claim 56.

6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-25, 51-55, and 57-74 are directed to the generic substrate.

7. During a telephone conversation with Chris Kyriakou on January 28th, 2002 a provisional election was made with traverse to prosecute the invention of Group I claim 1-25 and 51-74, with the species election of a non-woven substrate. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-50 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is advised that the reply to this requirement to complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 8, 9,12,18,64,67 and 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-7, 10,11,13,14,17,19-22, 24, and 25 are further rejected for their dependency on claim 1.

11. Claim 1 is indefinite because of the phrase "more readily enabled". It is unclear to the Examiner what is meant by the phrase "more readily enabled". In other words, "more readily enabled" than *what*?

12. Claims 9,12,64 and 67 are indefinite because of the language used to claim the pH range. The phrase "about, but not equal to 7" would include all values up to 7 and values slightly greater than 7 (i.e., 7.1). As such, it is not clear to the Examiner if the Applicant intends to limit the pH range to acidic values less than 7 or include acidic and slightly basic values, but not neutral values.

13. The term "highly" in claim 8 is a relative term which renders the claim indefinite. The term "highly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

14. Regarding claims 18,23 and 72, the phrase "or the like" renders these claims indefinite because these claims include elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102/103

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 1-5,15-25,51-61, and 70-74 are rejected under 35 U.S.C. 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Quincy et al., WO 00/50098.

The published PCT application to Quincy et al., discloses a thermoplastic layer material, which has been treated with a surfactant-modified odor control agent (Page 3, 1-5). Quincy et al., teaches that the thermoplastic layer may be non-woven filament web, a thermoplastic film, a foam layer or combination thereof (Page 3, 12-18). The non-woven web may be a single or multi-layer composite comprising one or more non-woven web, film, or foam layers (Page 11, 10-20). The odor control agent is mixed with a surfactant to yield a surfactant-modified odor control agent (Page 12, 25-30). Suitable surfactant compounds are those containing perfluoro and/or siloxane groups (Page 13, 25-27). Quincy et al., teaches that the treated thermoplastic layer materials are suitable for a variety of personal care absorbent product applications, such as diapers, training pants, swim wear, wipes, adult incontinence products and feminine hygiene products as well as medical absorbent products such as drapes, bandages, and wipes (Column 17, 20-30). Quincy et al., teaches that in the case of absorbent product applications, the treated layer material can be used as a cover sheet or containment matrix for an absorbent medium capable of absorbing liquids (Page 17, 25-28). The absorbent medium may include pulp fibers alone or in combination with a super-absorbent material (Page 17, 27-29).

Although, Quincy et al., does not explicitly teach lowering the surface tension such that the surfactant does not adversely effect the absorption capacity or wicking height of the second layer of the substrate, as the second layer of the substrate inactivates the surfactant as recited in claims 1,23, and 51, or the third surface tension values as recited in claims 52-55, it is reasonable to presume that said surface tension, absorption capacity or wicking height properties are inherent to the invention of Quincy et al. Support for said presumption is found in the use of like materials (i.e., surfactant-modified odor control agent and non-woven web materials which may be a single or multi-layer composite comprising one or more non-woven webs, films, or foam layers) and the use of like processes (i.e., applying or treating the surface of said non-woven materials with said surfactant-modified odor control agent), which would result in the claimed properties. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed properties of surface tension, absorption capacity or wicking height would obviously have been present once the Quincy et al., product is provided. *In re Best*, 195 USPQ at 433

Allowable Subject Matter

17. Claims 6-14, and 62-69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Specifically, these claims are allowable over the prior art of record since there is no teaching to an acidic or basic second substrate layer having pH values of those set forth in claims 9-14, and 64-69. Presently, there is no motivation or suggestion to combine references to form an obvious type rejection.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

ls
February 24, 2003

CHERYL A. JUSKA
PRIMARY EXAMINER